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No. 488 MISC.

IN THE

Supreme Court of the United States

OCTOBER TERM, 1957

J. IRIZARRY y PUENTE,
Petitioner,

v.

PRESIDENT AND FELLOWS OF
HARVARD COLLEGE AND ERWIN N. GRISWOLD,
Respondents.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT

J. IRIZARRY y PUENTE, prays that a writ of certiorari issue to review the judgment of the Court of Appeals for the First Circuit in this case.

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OPINIONS BELOW

The district court delivered an opinion on rendering its judgment which is reported in 149 F. Supp. 33-35 (RA 27-30). The opinion of the Court of Appeals (Appendix B, *infra*, pp. 30-35) is not yet officially reported.

JURISDICTION

The judgment of the Court of Appeals was entered on October 28, 1957 (Appendix C, *infra*, p. 36). The jurisdiction of this Court is invoked under 28 U.S.C. Section 1254.

QUESTIONS PRESENTED

I. Whether in an action for breach of confidence, fraudulent misrepresentation, fraudulent concealment, and unfair competition, brought by petitioner against respondents, for the misappropriation of a concrete literary idea of a foreign tax law service, communicated in confidence by petitioner to respondent Griswold, the district court was authorized, in passing on respondents' motion for summary judgment, to substitute its own theory of implied contract for petitioner's theory of confidential relationship, and rendering judgment accordingly.

II. Whether the district court was authorized, under Rule 56(c), Rules of Civil Procedure, to render summary judgment without determining, as a prerequisite thereto, that no genuine issue of fact existed to be submitted to the jury under petitioner's jury demand.

III. Whether on respondents' motion for summary judgment, the district court was authorized to decide the issues of novelty and originality raised by the pleadings, the depositions taken, the admissions on file, and the affidavits submitted, where there has been a jury demand which has not been stricken or waived.

IV. Whether the exchange of letters between petitioner

and respondent Griswold constituted a confidential relationship to be determined by the jury as an issue of fact.

V. Whether the pleadings, depositions and affidavits raised issues of fact as to the novelty and originality of petitioner's idea of a foreign tax law service; and whether the idea of such service was common knowledge when it was disclosed to respondent Griswold.

VI. Whether the district court correctly ruled that petitioner's concrete literary idea of a foreign tax law service communicated in confidence by petitioner to respondent Griswold, was required to be original and novel.

VII. Whether on an appeal from a summary judgment in a case where petitioner demanded a jury trial, the Court of Appeals had the right to decide that petitioner had published his idea of a foreign tax law service prior to the time when he disclosed such idea in confidence to respondent Griswold.

VIII. (a) Whether the Court of Appeals lawfully denied petitioner's motion to strike or to limit the scope and effect of respondent's brief for lack of responsiveness to petitioner's statement of questions involved, pursuant to Rule 24(3)(b) and (4)(b), of the Rules of that court, and for presenting for decision, questions not limited to, and not dealing with the rulings made, the points of law decided, or the judgment of the district court; (b) Whether on petitioner's appeal from a summary judgment under Rule 56(c), Rules of Civil Procedure, the Court of Appeals had authority to consider and decide the issues of confidential relationship and publication of petitioner's idea, which were not considered or decided by the decision and judgment of the district court; and (c) Whether the Court of Appeals abused its discretion in denying petitioner's oral motion for leave to submit a brief in opposition to respondents' argument on the issues of confidential relationship and publication of petitioner's idea.

IX. Whether the district court erred in ignoring the issue of the credibility of the testimony of respondent Griswold and of William Sprague Barnes, an interested witness.

CONSTITUTIONAL PROVISION AND FEDERAL RULES OF CIVIL PROCEDURE INVOLVED.

The Seventh Amendment, United States Constitution; Rules 38(b), 39(a) and 56(c), Rules of Civil Procedure; and Rule 24(3)(b) and (4)(b), of the Court of Appeals for the First Circuit, are printed in Appendix A, *infra*, pp. 26-28.

STATEMENT*

This is an appeal from a summary judgment entered in the United States District Court for the District of Massachusetts, on February 27, 1957 (RA 30).

Petitioner sued in the District Court for that District on the ground of diversity of citizenship, 28 U.S.C. Section 1332.

The facts, as set out in the findings included in the decision of the district court (RA 27-30) and in the opinion of the Court of Appeals (Appendix B, *infra*, pp. 30-35), may be summarized as follows:

The complaint consists of four counts. Counts 1 and 2 allege that respondents converted to their own use petitioner's idea of a tax service disclosed in the correspondence between petitioner and respondent Griswold in 1950; counts 2 and 3 allege that respondent Griswold deceived petitioner into disclosing his plans for a tax service. Damages, an accounting for profits, and injunctive relief, were sought.

On May 17, 1950, petitioner wrote to respondent Griswold and asked him if he would consider acting as the American Advisory Editor for petitioner's proposed series of Latin American loose-leaf tax services; and included with his letter a copy of the 50-page printed format of part I of his Argentine manuscript (RA 20). These Services were to be "along the lines of the Tax Services published in this country on federal and state taxes by Prentice-Hall and Commerce Clearing House" (RA 19).

(*) RA = Petitioner's Record Apendix in Court of Appeals.
App. RA = Respondents' Record Appendix in Court of Appeals.

On May 22 respondent Griswold wrote to petitioner expressing interest in the latter's proposal and asking for additional information "before coming to any conclusion" (RA 21).

On May 25 petitioner furnished Griswold additional information, and told him that his job would be to see that the statement of foreign tax laws was "in such form that it will be understood by an American executive or lawyer" (RA 22).

On the same day Griswold replied that he remained interested but still felt the need of rather more specific and definite information, and wanted to see more of the material (RA 24).

Thereafter petitioner mailed to Griswold a copy of the 50-page printed format of part II (RA 5); and on August 18 Griswold wrote to petitioner that he did not care to pursue the matter further (RA 25).

Subsequently, the Harvard Law School embarked on a project of collecting and publishing foreign tax information in cooperation with the UN. The project, according to the Court of Appeals, grew out of discussions in October 1950 between Harvard Law School and UN officials.

Respondents moved for summary judgment on five grounds: (1) that petitioner disclosed nothing novel and had no proprietary rights in the matters disclosed; (2) that there was no factual basis for the complaint; (3) that respondents did not violate any obligations owed to petitioner; (4) that the action was barred by the statute of limitations, and (5) that petitioner had not been damaged by any acts of respondents (RA 27). The motion was opposed by petitioner with four depositions and two counter-affidavits. The motion was granted by the district court on the sole ground of lack of novelty and originality of petitioner's idea (RA 27); and the Court of Appeals affirmed on that and two other grounds (Appendix B, *infra*, pp. 33-35).

From their summary, the courts below omitted the following facts, which are essential to the proper understanding and determination of petitioner's case:

1. That the district court substituted its own theory of implied contract for petitioner's theory of confidential relationship, and decided the motion on that theory;

2. That petitioner had demanded a jury trial (RA 18);

3. That the district court ruled on the motion without disposing of petitioner's jury demand;

4. That the district court decided the issues of novelty and originality although the jury demand was in effect;

5. That the district court made no determination that there were no genuine issues of fact to be tried by the jury;

6. That the district court ignored the issue of confidential relationship between petitioner and respondent Griswold;

7. That Harvard Law School had no course of study or research program in foreign taxation in May, 1950, when petitioner disclosed his idea to Griswold; and that the Foreign Law Research Study was set up at the Law School in September, 1950 (within one month after Griswold's last letter to petitioner of August 18, and one month before Barnes's visit to the UN around the middle of October), to "edit the [World Tax] Service";

8. That Griswold had, in May, 1950, no knowledge of foreign taxation, or of the foreign tax material in the American law book market, or of the UN resolutions on foreign taxation;

9. That petitioner moved in the Court of Appeals to strike respondents' brief for lack of responsiveness to petitioner's statement of questions involved; and that the motion was denied;

10. That the survey conducted by New York University in 1949 was limited to a "selected list", and that its purpose was to "determine the measure of interest in such service";

11. That while respondent Griswold was carrying on his correspondence with petitioner, he was simultaneously carrying on an exchange of letters and having personal interviews with William Sprague Barnes, a Harvard Law School graduate, to get him to go to Harvard to work on a tax project which embodied petitioner's idea and plan of execution;

12. That the issue of novelty or lack of novelty has no bearing on the issues of fraudulent misrepresentation, fraudulent concealment, and unfair competition, raised in the complaint;

13. That petitioner demanded *punitive* damages.

In short, the district court and the court of appeals omitted from their opinions all reference to the allegations of the complaint and counter-affidavits, and to the evidence in the record, which would have supported petitioner's right to have his case go to the jury; and spared no effort to treat the case as though petitioner were the wrongdoer instead of the party aggrieved, and respondents were immune from the normal processes of the law.

REASONS FOR GRANTING THE WRIT

I. *The district court substituted its own theory of implied contract for petitioner's theory of confidential relationship.* The complaint alleges that petitioner's idea and plan were disclosed to respondent Griswold in confidence, and that respondents subsequently misappropriated and used his idea and plan without his consent in violation of that confidence (RA 6). These allegations are denied in their answer and motion for summary judgment.

The correspondence between petitioner and respondent Griswold (RA 19-25) shows that the disclosure was made in an effort to enlist his "cooperation" as "advisory editor", for which he was to be compensated (RA 20, 22); that Griswold expressed "interest" on two occasions in petitioner's proposal and every time asked for more information as to what was expected of him and as to his compensation, "before coming to a conclusion" (RA 21, 24); and that the project was to be published by petitioner (RA 19). Griswold deposed that petitioner only wanted him to be an editor (R. 116, 123), and that petitioner was not trying to *sell* him his idea (R. 123). There was in this exchange, no meeting of the minds on a contract either to *sell* or to let respondents *use* petitioner's idea. The prayer for *punitive* damages (RA 17) lends weight

to the argument that the complaint is in tort, and not in contract, *National Discount Corp.* v. *O'Mell*, 6 Cir., 194 F.2d 452, 454; *Schreyer* v. *Casco Products Corp.*, 2 Cir., 190 F.2d 921.

The district court took the position that when the author of an idea voluntarily submits to another the information contained in his idea, "no promise by the recipient [Griswold] to pay for its *use* can be implied" if the elements of novelty and originality are absent (RA 28-29). This position was sustained by the Court of Appeals (Appendix B, *infra*, p. 33-34). The statement could hardly apply to the facts before the district court because it assumed that petitioner had submitted his idea to respondent Griswold to be *used* by him, whereas the complaint, the correspondence, and Griswold's own deposition make it clear that the idea was to remain in petitioner's possession, that it was to be published by him, and that respondents were not to have any *use* of it.

The opinion of the district court states that if petitioner's idea is "common knowledge and does not suggest anything new", and that it finds that there is "nothing new in the idea", and that it is neither novel nor original (RA 29, 29-30), shows that it acted on the implied contract theory, for which it found support in two implied contract cases. If the court below had acted on the confidential relation theory of the complaint, it would have had to find that *novelty as to the respondents* was all that was required under such theory, regardless of how common the knowledge of the idea had become, *Allen-Qualley Co.* v. *Shellmar Products Co.*, D.C.N.D. Ill., 31 F.2d 293, 294, aff'd., 7 Cir., 31 F.2d 623; *Smith* v. *Dravo Corp.*, 7 Corp., 203 F.2d 369, 376; *Franke* v. *Wiltschek*, 2 Cir., 209 F.2d 493; *Pidot* v. *Zenith Radio Corp.*, 308 Ill.App. 197, 31 N.E.2d 385, c.d. S.Ct. Ill.

These propositions of law, applicable to this case, are well-settled. (1) That the theory of the complaint determines the character of the action, *National Discount Corp.* v. *O'Mell*, 6 Cir., 194 F.2d 452, 454; *First National Bank* v. *McGuire*, 7 Cir., 184 F.2d 620, 624-625; *Junker* v. *Fobes*, 45 F. 840, 841;

Welsh v. *Darragh*, 52 N.Y. 590, 592. (2) That the judgment must conform to the theory of the complaint and the proofs, *The Hoppet*, 7 Cranch (11 U.S.) 389, 394; *Reynolds* v. *Stockton*, 140 U.S. 254, 265-266; *United States* v. *Seminole*, 299 U.S. 417, 422; *Sylvan Beach, Inc.* v. *Koch*, 8 Cir., 149 F.2d 852, 861-62; *Armand Co.* v. *Federal Trade Commission*, 2 Cir., 84 F.2d 973, 974, c.d. 296 U.S. 650; *Hoffritz* v. *United States*, 9 Cir., 240 F.2d 109, 110. (3) That the trial court cannot substitute its own theory for that of the complaint, *Wright* v. *Delafield*, 25 N.Y. 266, 269, 270; *Claris v. Richards*, 260 N.Y. 419, 424, 183 N.E. 904; *Nashua River Paper Co.* v. *Lindsay*, 242 Mass. 206, 136 N.E. 358, 359. (4) That Rule 56(c) requires the court to rest its decision and judgment on the pleadings and proofs, *Fountain* v. *Filson*, 336 U.S. 681, 683; *Hoffritz* v. *United States*, 9 Cir., 240 F.2d 109, 110.

The courts below ignored all these rules. The result has been that in substituting the *contract* theory for petitioner's theory of *confidential relationship*, the courts nullified petitioner's pleadings and invalidated his proofs, and that petitioner's rights were adjudicated on a theory completely foreign to the complaint, which his proofs could not support.

II. *The district court, in ruling on the motion for summary judgment, failed to determine that there were no genuine issues of fact.* The decision of the district court on the motion makes no determination that no genuine issues of fact existed that required submission to the jury under petitioner's jury demand (RA 18). Rule 56(c) required the court to make that determination, as a prerequisite to its judgment on the motion, *William J. Kelly Co.* v. *Reconstruction Finance Corp.*, 1 Cir., 172 F.2d 865, 866; *Hazeltine Research, Inc.* v. *General Electric Co.*, 7 Cir., 183 F.2d 3, 7; *Byrnes* v. *Mutual Life Ins. Co.*, 9 Cir., 217 F.2d 497, 500, c.d., 348 U.S. 971; *New & Used Auto Sales, Inc.* v. *Hanson*, 9 Cir., 245 F.2d 951, 953; *Dewey* v. *Clark*, D.C.Ct.App., 180 F.2d 766, 772; *Blakely* v. *United Ins. Co.*, D.C.Mun.Ct.App., 87 A.2d 532, 533-34; 6 Moore's Federal Practice, p. 2101.

The Court of Appeals has attempted to correct this fatal omission of the district court by saying (Appendix B, *infra*, p. 33) that affidavits and depositions were filed by both parties from which the district court "concluded that there was no genuine issue as to any material fact." This is not correct. Careful reading of the opinion of the district court fails to show that it reached any conclusion as to the inexistence of a material issue of fact in the case. What it did was to decide in favor of respondents the contested issues of novelty and originality. The statement of the Court of Appeals cannot cure the omission of the district court on so important a point.

III. *The district court tried the contested fact issues of novelty and originality of petitioner's idea of a foreign tax service while his jury demand was in effect.* Petitioner demanded a jury trial (RA 18). He had a right to make that demand under the Seventh Amendment and Rule 38(b), Rules of Civil Procedure, as to any issues of fact in the case triable of right by a jury; unless (1) he had stipulated to consent to trial by the court sitting without a jury, or (2) the court upon motion or of its own initiative had *found* that a right to trial by jury of some or all of those issues *did not exist* under the Constitution or statutes of the United States, Rule 39(a), Rules of Civil Procedure; *Kelly* v. *Shamrock Oil & Gas Corp.*, 5 Cir., 171 F.2d 909, 911, c.d. 337 U.S. 917. Neither of these conditions are present in this case.

Rule 39(a) made it mandatory upon the district court to make a definite finding or order to that effect. *Barber* v. *Turberville*, D.C.Ct.App., 218 F.2d 34, 37; *Ring* v. *Spina*, 2 Cir., 166 F.2d 546, 550. But the district court, without such finding or order, proceeded to try those issues, and *decided:* (1) that the Harvard reports "will be completely different . . . from [petitioner's] Argentine Federal Tax Law Service" (RA 28); (2) that petitioner "admits that there is nothing new in the *idea* of a tax service as such" (RA 29); (3) that "there were at the time this cause of action accrued foreign tax services on the market" (RA 29-30); (4) that "there could not

have been anything novel or original in [petitioner's] idea" (RA 30); and (5) that petitioner "had no proprietary rights in the *idea* of a foreign tax service and cannot recover" (RA 30) on any of the counts.

IV. *The existence of a confidential relationship between petitioner and respondent Griswold raised an issue of fact for the jury.* The allegations of the complaint that petitioner disclosed his idea to respondent Griswold "confidentially and for the purpose only of apprising him of [petitioner's] project and making it a success" (RA 6), and that the exchange of correspondence between them (RA 19-25) established a relation of confidence whereby respondents "assumed and owed [petitioner] the legal duty not to convert or misappropriate" the idea without petitioner's consent (RA 6), were denied by respondents in their answer and motion for summary judgment. The district court, in ruling on the motion, ignored these allegations in the pleadings; but the Court of Appeals *decided* that "it is perfectly clear that no such * * * fiduciary relationship arose" (Appendix B, *infra*, p. 35). Petitioner wishes to point out to this Court that on October 25, 1957—three days before Judge Maris wrote the opinion in the instant case on October 28—he joined Judges Staley and Hastie, in *International Industries, Inc.* v. *Warren Petroleum Corp.*, 3 Cir., 248 F.2d 696, 703-704, in holding that the function of the Court of Appeals is "not to weigh the evidence, but to review the record with the object of determining whether the findings of the district court were clearly erroneous—that is, whether we are left with a firm impression that the findings were wrong."

The court of appeals went beyond its lawful authority in sitting as a trial court and deciding such issue, *Arnstein* v. *Porter*, 2 Cir., 154 F.2d 464, 474; *Anderson* v. *Federal Cartridge Corp.*, 8 Cir., 156 F.2d 681, 684. The issue was one of fact for the jury, and it could not be disposed of in a motion for summary judgment, *Carl Byoir & Associates* v. *Tsune-Chi-Yu*, D.C.S.D.N.Y., 36 F.Supp. 962; *Krause* v. *George K. Gar-*

rett Co., D.C.D.Del., 5 F.R.D. 385; *Gate-Way, Inc.* v. *Wilson*, 94 Cal.App. 706, 211 P.2d 311; *Klein* v. *Ekco Products Co.*, 135 N.Y.S.2d 391, 395, affd., 139 N.Y.S.2d 258; *Taylor* v. *Shields*, Ohio App., 111 N.E.2d 595; *Thompson* v. *California Brewing Co.*, 150 A.C.A. 565, 310 P.2d 436, 439.

This is particularly true in view of the joint adventure character of the relationship proposed by petitioner to respondent Griswold, which is *per se* fiduciary in nature, *Hey* v. *Duncan*, 7 Cir., 13 F.2d 794, 795; *Libby* v. *L. J. Corporation*, D.C.Ct. App., 247 F.2d 78, 81.

V. *The pleadings, depositions and affidavits raised issues of fact for the jury on the questions of Novelty and Originality of petitioner's idea.* (a) THE PLEADINGS. The complaint alleged that petitioner's basic idea and plan "were original, useful, new, and novel in all respects" (RA 7). Respondents denied this allegation in their answer and motion. The pleadings thus raised issues of fact. The district court should have taken the allegations of the complaint as true for the purpose of deciding the motion, *Landy* v. *Silverman*, 1 Cir., 189 F.2d 80, 82; *United States* v. *St. Paul-Mercury Indemnity Co.*, 3 Cir., 194 F.2d 68; *Campana Corp.* v. *Harrison*, 7 Cir., 135 F.2d 334, 335-336; *Harris* v. *Railway Express Co.*, 10 Cir., 178 F.2d 2, thereby precluding summary judgment, *Landy v. Silverman*, 1 Cir., 189 F.2d 80, 82.

Respondents filed affidavits seeking to show lack of novelty of petitioner's idea. Petitioner filed a counter-affidavit that his idea, as typified in his Argentine manuscript, "owed its origin to deponent," and that "it had never before 1946 or since, been known, thought of, or manufactured in the United States or elsewhere" (RA 26). The affidavits also raised issues of fact; and the facts alleged in petitioner's affidavit should have been accepted by the district court as true, *Desny* v. *Wilder*, 46 Cal.2d 715, 299 P.2d 257, 261. Respondents affidavits were improperly treated, for the purpose of the motion, as proof contradictory to the well-pleaded facts in the complaint, *Farrall* v. *District of Columbia Amateur*

Athletic Union, D.C.Ct.App., 153 F.2d 647, 648; *Frederick Hart & Co.* v. *Recordograph Corp.*, 3 Cir., 169 F.2d 580, 581; *Carr* v. *City of Anchorage*, 9 Cir., 243 F.2d 482, 483; *Schwob* v. *International Water Corp.*, D.C., 136 F.Supp. 310, 311.

Since petitioner's and respondents' affidavits were conflicting as to the facts, the district court had no authority to grant the motion for summary judgment, *Sartor* v. *Arkansas Natural Gas Co.*, 321 U.S. 620, 627; *Sarnoff* v. *Ciaglia*, 3 Cir., 165 F.2d 167; *Bowers* v. *E. J. Rose Mfg. Co.*, 9 Cir., 149 F.2d 612, 616, c.d. 326 U.S. 753; *Norwood Morris Plan Co.* v. *McCarthy*, 295 Mass. 597, 4 N.E.2d 450.

(b) DEPOSITIONS AND EXHIBITS. (i) *That Idea was Original and Novel.* Petitioner's letter to Griswold of May 17, 1950 (RA 19), described his proposed Services as containing some new features not found in domestic tax services. Mr. William M. Vanneman, Secretary-Treasurer, Matthew Bender & Co., law book publishers, deposed that in 1946, when his company became interested in petitioner's project, he personally conducted an investigation of the law book market and that it did not disclose a tax law service such as that proposed by petitioner (R. 14-15); that publication of such a project as outlined to him by petitioner would have been "something entirely new in [his] publishing field" (R. 17); that there was no "foreign tax law on the market, or foreign tax law material in the United States law book market in 1946" (R. 18-19, 20); that there has been nothing in the American law book market since 1946 which resembles petitioner's Argentine Federal Tax Law Service as to arrangement, contents, combination of materials and comprehensiveness of treatment; or that embodies the features of text treatment and annotated statutes correlated; and that a foreign tax law service like petitioner's Argentine Service has never been known or manufactured in the United States law book market in 1946, in 1950, or in 1956 (R. 30-31).

Respondent Griswold deposed that he thought petitioner's idea was "an interesting idea that had definite possibilities"

(R. 22-23); that "it had never been done" (R. 26-27); that there was in English "nothing comparable to it" (R. 106); that he knew "of no foreign tax law which is as much as a service in that sense as [petitioner's] Argentine Tax Service; that there was nothing until 1951 when petitioner's Service was published (R. 112); and that he knew of no others which are as much of a service that have been published since 1951 (R. 113).

(ii) *That idea was not Original and Novel.* Respondent Griswold deposed that he did not think petitioner "had any novel or original idea" (R. 26-27, 106, 109); that it did not "involve invention" (R. 108).

The depositions and exhibits definitely show a factual conflict on the issues of novelty and originality of petitioner's idea. The burden rested on respondents, rather than on petitioner, to show the absence of an issue of fact, *Warner* v. *First National Bank*, 8 Cir., 236 F.2d 853, 857; *Zampos* v. *U. S. Smelting, Refining & Mining Co.*, 10 Cir., 206 F.2d 171, 174; *Judson* v. *Peoples Bank & Trust Co.*, 17 N.J. 67, 110 A.2d 24, 27 (Mr. Justice Brennan); and if there was the slightest doubt, *Gottlieb* v. *Isenman*, 1 Cir., 215 F.2d 184, 186; *Shafer* v. *Reo Motors, Inc.*, 3 Cir., 205 F.2d 685; *Zampos* v. *U. S. Smelting, Refining & Mining Co.*, 10 Cir., 206 F.2d 171, 174; or uncertainty, *Hoffman* v. *Babbitt Bros. Trading Co.*, 9 Cir., 203 F.2d 636, as to the facts; or if conflicting inferences could be drawn from the facts, *Lavin* v. *Goldberg Building Material Corp.*, 274 App.Div. 690, 87 N.Y.S.2d 90, app. den., 89 N.Y.S.2d 523, 275 App. Div. 865, the motion should have been denied. Respondents did not sustain the burden on this issue.

(c) *Novelty and Confidential Relationship.* The district court found from what it called "uncontradicted affidavits"[1] of respondents, that there were at the time the cause of action accrued, "foreign tax services on the market", that is, that

[1] This is an inaccurate statement. Petitioner's RA p. 26, in the Court of Appeals, gives the text of his counter-affidavit in opposition to the affidavits filed by respondents.

petitioner's idea was "already a matter of common knowledge" (RA 29), and that it could not have been anything novel or original (RA 29-30). This conclusion of the court raises two questions: (i) *Was the idea of a foreign tax law service new and novel as to Harvard Law School?* Both Griswold and Barnes deposed that prior to May 17, 1950, when petitioner disclosed his idea to Griswold, Harvard Law School had not developed any program in foreign taxation (Griswold 77, 113), and had no plans for a foreign tax law service (Griswold 124); that it had no long-range plans to publish any tax reports (Barnes 45); had not considered any foreign law research study until September of that year (Barnes 7, 8, 158), and had never discussed a World Tax Series before that time at Harvard (Barnes 91). (ii) *Was the idea new and novel as to Griswold?* He deposed that prior to petitioner's letter of May 17, 1950 (RA 19) he had "no substantial knowledge, no sufficient knowledge of any service in English on foreign taxes. I had never been particularly interested in foreign taxes as such and had made no effort to study the material in the field, although I was aware there was a great inadequacy in the material that was available to lawyers" (R. 117). He had no personal knowledge of any Foreign Tax Law Services in the United States law book market in 1946, or 1950 (R. 110, 111, 112, 112-113). He had "little or no contact with foreign tax laws" (R. 21), and knew nothing of the UN resolutions on taxation (R. 114): "It is not clear to me that I had ever heard of these resolutions before I saw this affidavit [Lachmann's, of April 4, 1956; App. RA 40-47]" (R. 115). He deposed that it was a fair statement to say that he had never heard of the UN resolutions, and never had any knowledge of them before July, August, or September of 1950 (R. 115).

If there was a confidential relation between petitioner and respondent Griswold by reason of the exchange of correspondence running from May 17 to August 18, 1950, the law only required that the idea disclosed be *new as to the respondents at the time of the disclosure*, so that it was immaterial whether

or not the idea was a matter of common knowledge when it was disclosed in May, *supra*, p. 14-15.

It is obvious from the pleadings, the depositions, and affidavits, that the originality and novelty of petitioner's idea presented these three issues of fact: (1) Was the idea of a foreign tax law service *novel* in 1950? (2) Was it *common knowledge* then? (3) Was it *novel as to Griswold and Harvard Law School* then? These were issues which could not be resolved on a motion for summary judgment on the basis of affidavits. Moreover, questions of novelty and originality are issues of fact for the jury, *Dezendorf* v. *Twentieth-Century-Fox Film Corp.*, 9 Cir., 99 F.2d 850, 851; *Hamilton National Bank* v. *Belt*, D.C.Ct.App., 210 F.2d 706, 708; *John W. Shaw Advertising, Inc.* v. *Ford Motor Co.*, D.C.N.D.Ill., 112 F.Supp. 121, 123.

VI. *The judgment below is based on the fictitious issue of novelty and originality.* Petitioner disclosed to respondent Griswold a concrete literary idea; and that idea was not required to be *novel* and *original* in the technical patent law sense, to entitle it to the protection of the common law, *Baker* v. *Selden*, 101 U.S. 99, 102; *Sheldon* v. *Metro-Goldwyn Pictures Corp.*, 2 Cir., 81 F.2d 49, 53, c.d., 298 U.S. 669; *Stein* v. *Mazer*, 4 Cir., 204 F.2d 472, 474, affd., 347 U.S. 201, 218; *Wihtol* v. *Wells*, 7 Cir., 231 F.2d 551, 553; *Desny* v. *Wilder*, 46 Cal.2d 715, 741, 299 F.2d 257, 271. It was only required to be *original* in the copyright sense, *Mazer* v. *Stein*, 347 U.S. 201, 217; *Alfred Bell & Co.* v. *Catalda Fine Arts*, 2 Cir., 191 F.2d 99, 102; *Gerlach-Barklow Co.* v. *Morris & Bendien*, 2 Cir., 23 F.2d 159, 161; *Wihtol* v. *Wells*, 7 Cir., 231 F.2d 550, 553. Hence, the decision and judgment of the district court, affirmed by the Court of Appeals, is based on a fictitious issue.

The Court of Appeals said that if respondents had been charged with having copied the *text* of petitioner's copyrighted Argentine Tax Service, "it would be immaterial that the idea of a foreign, or even an Argentine Tax Service was

an old and well known one." But it went on to point out that since petitioner charged respondents with misappropriating his *idea* of publishing such a service, petitioner had no proprietary right in it unless the idea was a "novel and original conception with him." (Appendix B, *infra*, p. 34). In drawing a distinction between *infringement of copyright* and *misappropriation of idea*, the court ignored the established principle that in cases involving the misappropriation of ideas, the element of *novelty* is not required where the action proceeds on the theory of confidential relationship, Restatement of Torts, Sec. 757, pp. 4, 5, 6. 7, 8, 9; *Allen-Qualley Co.* v. *Shellmar Products Co.*, 31 F.2d 293, affd., 36 F.2d 623; *A. O. Smith Corp.* v. *Petroleum Iron Works Co.*, 6 Cir., 73 F.2d 531, 538-39; *Saco-Lowell Shops* v. *Reynolds*, 4 Cir., 141 F.2d 587, 597; *McKinzie* v. *Cline*, 197 Ore. 184, 252 P.2d 564, 565, 567; *Jones* v. *Ulrich*, 342 Ill.App. 16, 95 N.E.2d 113, 117, 118; *Consolidated Boiler Corp.* v. *Bogue Electric Co.*, 141 N.J.Eq. 550, 58 A.2d 759, 769. If respondent Griswold obtained the idea as a result of a confidential relationship, it should be protected regardless of its novelty or ownership by petitioner, *DuPont de Nemours Powder Co.* v. *Masland*, 244 U.S. 100, 102; *Aktiebolaget Bofors* v. *United States*, D.D.Ct.App., 194 F.2d 145; *International Industries, Inc.* v. *Warren Petroleum Corp.*, D.C., 99 F.Supp. 907, 913, affd. 248 F.2d 696.

The courts below erred in deciding the factual issue of the proprietorship by petitioner of his idea of a foreign tax service vis-a-vis respondents, inasmuch as that issue was one for the jury, *Matarese v. Moore-McCormack Lines, Inc.*, 2 Cir., 158 F.2d 631, 635; *Golding* v. *RKO Radio Pictures, Inc.*, Cal.App., 193 P.2d 153, affd., 35 Cal.2d 690, 221 P.2d 95; *Stanley* v. *Columbia Broadcasting System, Inc.*, Cal.App., 192 P.2d 495, affd., 208 P.2d 9.

VII. *Petitioner's project for a foreign tax service was not published prior to 1951, as the Court of Appeals decided.* The complaint alleged that petitioner's idea and plan of execution "had never before been published or dedicated to the public"

(RA 7; par. 13). Respondents' answer denied these allegations.

The issue of publication or dedication to the public was not raised in the answer or in the motion as an affirmative defense, Rule 12, Rules of Civil Procedure.

In 1949 New York University, which was then interested in furthering the publication of petitioner's project, conducted a survey in order to "form a reliable judgment of the practicability of such a project" (App. RA 31-32). An outline of the proposed project (App. RA 33-36) was prepared by William M. Vanneman (Vanneman R. 21), who was and still is an officer of Matthew Bender & Company, law book publishers. He deposed that he prepared for the University the questionnaire and covering letter referred to above (R. 20-21); and that they went to a "selected list" (R. 26); that its purpose was "to determine the market for a Latin American Tax Service"; that he has conducted similar surveys before on other publications submitted to his company; that those surveys are usually made "prior to conclusion of a contract"; and that making such surveys is "a normal practice in the law book publishing field" (R. 27).

Petitioner's letter of May 17, 1950, to respondent Griswold informed him that a substantial survey had been conducted "in order to determine the measure of interest in such Service" (RA 20). In the fall of 1949 petitioner printed a limited number of copies of the formats of Parts I and II, of his Argentine manuscript, in their final form, which he used in securing pre-publication orders (Compl., Count I, par. 8; RA 4). Whether the survey and the use of the formats in securing orders constituted an abandonment, publication or dedication to the public, raised an issue of fact. "Abandonment is a question of intent," *International News Service* v. *Associated Press*, 248 U.S. 215, 240-241; and intent is an issue of fact for the jury, *Blakeslee* v. *Wallace*, 6 Cir., 45 F.2d 347; *Ochs* v. *Woods*, 221 N.Y. 335, 117 N.E. 305.

The question of publication was not considered and decided

by the district court; but the Court of Appeals did consider and *decide* that there had been an "unconditional public disclosure" which deprived petitioner of his proprietary rights in his idea (Appendix B, *infra*, p. 34-35). The court below had no right to disregard petitioner's statement in his complaint that his idea had never been published or dedicated to the public, and decide the issue for respondents in an appeal from a summary judgment where petitioner had asked for a jury trial.

Moreover, the decision of the Court of Appeals that there had been an unconditional disclosure is, as a question of substantive law, in direct conflict with the decision of this Court in *Ferris* v. *Frohman*, 223 U.S. 424, 435, and of other Courts of Appeals, *Werckmeister* v. *American Lithographic Co.*, 2d Cir., 134 F. 321, 323, 324; *Nutt* v. *National Institute*, 2 Cir., 31 F.2d 236, 238; *White* v. *Kimmel*, 9 Cir., 193 F.2d 744, 746, c.d. 343 U.S. 957.

VIII. *The Court of Appeals erred in denying petitioner's motions:* (1) *to strike respondents' brief, and* (2) *to file a brief in opposition to respondents' argument on the issues of confidential relationship and publication of petitioner's idea.* Petitioner moved in the Court of Appeals to strike or to limit the scope and effect of respondents' brief on two grounds: (1) that their statement of questions presented was not responsive to petitioner's statement of questions involved, and (2) that their statement was not limited to, and did not deal with the rulings made, the points of law decided, or the judgment of the district court, but related to independent issues not raised in petitioner's statement, and not dealt with in the district court's decision or judgment (Appendix B, *infra*, p. 29). The motion was denied.

Respondents' statement and brief dealt with all five grounds of their motion for summary judgment (App. RA 37). The judgment of the district court was based on the issue of novelty only (RA 27).

Rule 24(3)(b) and (4)(b) of the Court of Appeals for the

First Circuit required petitioner's brief to contain a statement of the questions involved if they disagreed with petitioner's statement. (Appendix A, *infra*, p. 27-28).

The purpose of petitioner's statement is to enable the court and opposing counsel to see on what points petitioner intended to ask for a reversal of the judgment, and to limit the discussion to those points, *Phillips & Colby Constr. Co.* v. *Seymour*, 91 U.S. 646, 648; *Seaboard Air Line Railway Co.* v. *Watson*, 287 U.S. 86, 91; *Anderson* v. *Federal Cartridge Corp.*, 8 Cir., 156 F.2d 681, 683; *Ashton* v. *Town of Deerfield Beach*, 5 Cir., 155 F.2d 40, 42; *Keeley* v. *Mutual Life Ins. Co.*, 7 Cir., 113 F.2d 633, 636; *Thys Co.* v. *Anglo California National Bank*, 9 Cir., 219 F.2d 131, 133, c.d. 349 U.S. 946.

Denial of the motion to strike or to limit resulted in permitting respondents to argue in the Court of Appeals issues outside the scope of petitioner's statement of questions involved, and gave that court an opportunity to consider and *decide* two issues of fact which were not considered and decided by the district court, namely, whether or not the exchange of correspondence between petitioner and respondent Griswold established a confidential relationship, and whether or not the survey conducted by New York University in 1949 and the use of the printed formats of petitioner's Argentine Service in securing pre-publication orders, constituted an unconditional public disclosure of petitioner's idea.

We thus have the Court of Appeals acting, not as a court of review of errors of law committed by the district court, but as a trial court assuming authority to decide issues of fact which were not passed upon by the district court, and were not properly before the appellate court for review in an appeal from a summary judgment, *Kennedy* v. *Silas Mason Co.*, 334 U.S. 249, 256; *Arnstein* v. *Porter*, 2 Cir., 154 F.2d 464, 473-474; *Anderson* v. *Federal Cartridge Corp.*, 8 Cir., 156 F.2d 681, 683.

The authority of the Court of Appeals extended only to allowing respondents to argue contentions that would have

supported the judgment of the district court on the issue of novelty, *United States* v. *Hark*, 320 U.S. 531, 534; but it exceeded its authority when, in an appeal under Rule 56(c), it allowed respondents to argue contentions that *enlarged their rights* and *lessened petitioner's rights*. Where issues have been *tried on the merits*, appellate courts have allowed arguments on the propriety of the action of the lower court without the need of a cross-appeal, *United States* v. *American Railway Express Co.*, 265 U.S. 425, 435; *Langnes* v. *Green*, 282 U.S. 531, 538; *Morley Construction Co.* v. *Maryland Casualty Co.*, 300 U.S. 185, 191; *LeTulle v. Scofield*, 308 U.S. 415, 421-22; *Jaffke* v. *Dunham*, 352 U.S. 280, 281; *Standard Accident Insurance Co.* v. *Roberts*, 8 Cir., 132 F.2d 794; *Drinan* v. *A. J. Lindeman & Hoverson Co.*, 7 Cir., 238 F.2d 72, 74. Under those circumstances all respondents could have done was to support the judgment on *novelty*, and oppose petitioner's statement of questions involved, *Landram* v. *Jordan*, 203 U.S. 56, 62; *The "Stephen Morgan"*, 94 U.S. 599. This Court has said in the *Morley* case, supra, at page 191, that respondents cannot ask the Court of Appeals to revise the findings of the district court where a *revision of those findings* carries with it as an incident a *revision of the judgment*. The Court of Appeals considered and *decided* two new issues: unconditional public disclosure of petitioner's idea, and inexistence of confidential relationship. This means that not only would petitioner be barred from recovery because there was no novelty in his idea, but also because he had made a public disclosure of that idea, and there was no confidential relationship between himself and Griswold when the disclosure was made. This carries with it by implication a revision of the judgment, *Anderson v. Federal Cartridge Co.*, 8 Cir., 156 F.2d 681, 683.

After counsel for respondents concluded his oral argument in the Court of Appeals on the questions of confidential relationship and unconditional public disclosure of petitioner's idea, petitioner moved the Court for leave to file a memo-

randum on the facts and the law in opposition. The Court denied the motion. This action of the Court was an abuse of its discretion in view of the fact that it permitted counsel for respondents to argue on appeal two new issues not considered by the district court.[2]

These are questions of first impression under Rule 56(c) of the Rules of Civil Procedure, and raise these important issues: (1) whether on an appeal under Rule 24 of the Court of Appeals, and similar rules in other circuits, issues not decided below can be considered on appeal when a decision on the issues would enlarge the rights of appellees or lessen the rights of appellants, and (2) whether the Court of Appeals had authority to *decide* issues of fact reserved by Rule 56(c) to the district court.

IX. *Summary judgment should not have been granted in view of the testimony impeaching the credibility of respondent Griswold and the interested witness Barnes.* The record contains the exchange of correspondence between petitioner and respondent Griswold (RA 19-25). It also shows that Harvard Law School was not carrying on any work on foreign taxation prior to the date of petitioner's disclosure of his idea to respondent Griswold on May 17, 1950 (Barnes 18, 45, 48, 91); that no one at the Law School suggested taxes as part of the Foreign Law Research Study program (Barnes 25, 26, 152); that Barnes was appointed Director of the Study on July 1, 1950 (Barnes 3, 65) on the recommendation of respondent Griswold (Barnes 20-21); that the Study was organized in September, 1950 (Barnes 5, 9) for the sole purpose of editing the tax services (Barnes 82-83); that Barnes visited

[2] Notwithstanding the court's denial of petitioner's motion, petitioner sent to the court a list of authorities, which the clerk of the court returned on October 7, 1957, with the following statement: "I am directed by the Court to return herewith your letter of October 5, and copies thereof since the contents partake of the nature of a reply or supplemental brief which could be filed now only by leave which has not been granted; you may recall what was said about such briefs at the oral argument."

the UN in October to "inquire" about the tax activities of that organization (Barnes 80-81, 82; Lachmann's aff., par. 8, App. RA 44); that the "initial discussions" dealt only with the publication of a tax service (Barnes 82); that Barnes says he got the "idea" from Lachmann at the UN (Barnes 91, 152), and that Barnes proposed it at the Harvard Law School (Barnes 151-152).

The record also shows that Harvard Law School has maintained since October 1950 (Barnes 82-83) to April 1956 (App. RA 47) that the Law School was going to publish a World Tax Service (Barnes 79, 82-83, 90, 231; Griswold 51-52, 56, 59, 61, 61-62, 87, 88; App. RA 45-46, Lachmann's aff., pars. 10, 11); and that an International Tax Program has been put into operation at the Law School.

Barnes deposed that the main reason for the setting up of the Foreign Law Research Study was *not* foreign taxation (Barnes 18); but when confronted with Exhibit 7, prepared by the Harvard Law School on December 20, 1951 (Barnes 79), he had to admit that the Study was organized in September (one month before his visit to the UN), and that its purpose was "to edit the Service" (Barnes 82-83, 83); and that the "initial discussions" with the UN related solely to a "World Tax Law Service" (Barnes 82); so that when the Study was organized in September to edit the Services, respondents already were in possession of the "idea" which they claim came from the UN. In fact, Barnes stated in the Harvard Law School Bulletin for February 1955 (Exhibit A, Complaint), that the "original plan" for the Services resulted from the Foreign Law Research Study undertaken by the Law School in [September] 1950." But since Barnes deposed that he got the "idea" from the UN (Barnes 152), he had to admit that the information given out in the Bulletin was not exactly correct (Barnes 152).

Griswold deposed that the World Tax Service was planned as part of the World Tax International Program (Griswold 59); that the Program was not a part of the Service (Gris-

wold 57-58); that the Series or Service was an outgrowth of the Program (Griswold 7). But Exhibit 7, referred to above, shows that as discussions between the Law School and the UN progressed, "the possibility of converting an organization [the Foreign Law Research Study] created to edit the Service into the nucleus of a research and training program was examined," and that the understanding was reached that the research and training program was to be "an integral part of the cooperative program" (Barnes 82-83).

Barnes was compelled to admit also that the initial discussions were confined to the World Tax Law Service, and later developed the research and training program (Barnes 83); but Griswold deposed right along that it has never been the Law School's purpose to publish a World Tax Law Service (Griswold 52-53, 61, 65, 68, 86); although Lachmann, in his affidavit dated April 4, 1956, in support of the Motion for Summary judgment, states that the "United Nations Secretariat and Harvard University *are continuing to cooperate* in the preparation of these reports," (App. RA 46), which are to be "a world tax service," pursuant to the Resolution of the UN of August 10, 1951 (Lachmann's aff., par. 10; App. RA 45).

The depositions of Griswold and Barnes, when considered in the light of Exhibit 7, raise serious doubts as to their credibility on two issues: (1) Did respondents get the idea of a foreign tax law service from petitioner or from the UN; and (2) Are respondents' publications to be bound volumes or services?

This court has said that the fact that a defendant and a witness are interested in the outcome of the lawsuit, "is deemed sufficient to require the credibility of [their] testimony to be submitted to the jury as a question of fact." *Sartor* v. *Arkansas Natural Gas Co.*, 321 U.S. 620, 628. See also: *Arnstein* v. *Porter*, 2 Cir., 154 F.2d 464; *Hoeltke* v. *C. M.*

Kemp Mfg. Co., 4 Cir., 80 F.2d 912, 927, c.d., 298 U.S. 673; *Fidelity & Casualty Co.* v. *Talbot*, 5 Cir., 234 F.2d 425.

CONCLUSION

This court should grant the writ of certiorari prayed for because (1) the issues decided by the district court (originality and novelty), and by the Court of Appeals (publication and confidential relationship) are all questions of fact which the courts below had no right to decide while the jury demand was in effect; (2) the decisions below have introduced an element of confusion into federal practice under the Rules of Civil Procedure; (3) Rules 38, 39 and 56 have been completely disregarded by the courts below; (4) the courts below have substituted their own arbitrary discretion for the settled rules of procedure; (5) the decisions below have violated the due process and jury trial provisions of the Constitution; (6) the courts below have administered justice in this case according to their prejudices in favor of particular litigants rather than according to law; (7) the decisions below will necessitate a reassessment of the value of the Rules of Civil Procedure as instruments in the orderly administration of justice; (8) the decisions below turn on questions of federal practice and are in conflict with the decisions of this Court and of other Courts of Appeals on the same matters; (9) the decisions below decide important questions of procedure under Rules 38, 39 and 56 which have not been but should be settled by this Court; and (10) the decisions below have so far departed from the accepted and usual course of judicial proceedings as to call for the exercise of this Court's power of supervision.

Accordingly, it is respectfully submitted that the petition for a writ of certiorari should be granted.

J. IRIZARRY Y PUENTE, *Pro se*

January 1958.

APPENDIX A

SEVENTH AMENDMENT, U. S. CONSTITUTION:

"In Suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved, and no fact tried by a jury, shall be otherwise re-examined in any Court of the United States, than according to the rules of the common law."

FEDERAL RULES OF CIVIL PROCEDURE:

RULE 38. *Jury Trial of Right.*

(a) *Right Preserved.* The right of trial by jury as declared by the Seventh Amendment to the Constitution or as given by a statute of the United States shall be preserved to the parties inviolate.

(b) *Demand.* Any party may demand a trial by jury of any issue triable of right by a jury by serving upon the other parties a demand therefor in writing at any time after the commencement of the action and not later than 10 days after the service of the last pleading directed to such issue. Such demand may be indorsed upon a pleading of the party.

(c) *Same: Specification of Issues.* In his demand a party may specify the issues which he wishes so tried; otherwise he shall be deemed to have demanded trial by jury for all the issues so triable. * * *

(d) *Waiver.* * * * A demand for trial by jury made as herein provided may not be withdrawn without the consent of the parties.

RULE 39. *Trial by Jury or by the Court.*

(a) *By Jury.* When trial by jury has been demanded as provided in Rule 38, the action shall be designated upon the docket as a jury action. The trial of all issues so demanded shall be by jury, unless (1) the parties or their attorneys of

record, by written stipulation filed with the court or by an oral stipulation made in open court and entered in the record, consent to trial by the court sitting without a jury or (2) the court upon motion or of its own initiative finds that a right of trial by jury of some or all of those issues does not exist under the Constitution or statutes of the United States.

(b) *By the Court.* Issues not demanded for trial by jury as provided in Rule 38 shall be tried by the court; but, notwithstanding the failure of a party to demand a jury in an action in which such a demand might have been made of right, the court in its discretion upon motion may order a trial by a jury of any or all issues.

RULE 56. *Summary Judgment.*

b. *For Defending Party.* A party against whom a claim, counter-claim, or cross-claim is asserted or a declaratory judgment is sought may, at any time, move with or without supporting affidavits for a summary judgment in his favor as to all or any part thereof.

c. *Motion and Proceedings Thereon.* * * * The judgment shall be rendered forthwith if the pleadings, depositions, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law. * * *

RULES — COURT OF APPEALS FOR THE FIRST CIRCUIT:

RULE 24.

(3) The *brief of the appellant or petitioner* shall contain the following matter, under distinctive titles, arranged in the following order:

(b) *A statement of the questions involved,* setting forth each question separately, in the briefest and most general terms, without names, dates, amounts or particulars of any kind. Ordinarily no point will be considered which is not set

forth in or necessarily suggested by the statement of questions involved.

(4) The *brief of the appellee* or respondent shall contain the following matter, under distinctive titles, arranged in the following order:

(b) *A counter-statement of the questions involved* conforming to the requirements of paragraph (3)(b) of this rule, *if he disagrees with the statement of the appellant or petitioner.*

APPENDIX B

MOTION TO STRIKE OR TO LIMIT THE SCOPE AND EFFECT OF DEFENDANTS-APPELLEES' BRIEF.

Plaintiff-appellant shows:

1. That defendants-appellees' Statement of "QUESTIONS PRESENTED" Nos. 1 to 5, of their brief filed herein, is not responsive to plaintiff-appellant's "STATEMENT OF QUESTIONS INVOLVED", in that it does not conform to the requirements of Rule 24(3)(b) and (4)(b) of this Court.

2. That said Statement of "QUESTIONS PRESENTED", as aforesaid, is not limited to, and does not deal with, the rulings made, the points of law decided, or the judgment of the court below; but relates to independent issues not raised by plaintiff-appellant's "STATEMENT OF QUESTIONS INVOLVED", and not dealt with in the court's decision or judgment below.

WHEREFORE, plaintiff-appellant moves that defendants-appellees' brief filed herein be stricken from the files; or that its scope and effect be limited to the following questions:

(a) Is the issue of the "novelty" of the concrete literary idea and plan disclosed by plaintiff-appellant to defendant-appellee Griswold in May, 1950, fictitious, as claimed by plaintiff-appellant?

(b) Was the district court justified under Rule 56(c) of the Federal Rules of Civil Procedure, in ignoring the existence of the confidential relationship claimed by plaintiff-appellant to have resulted from his said disclosures to defendant-appellee Griswold in May, 1950?

ORDER OF COURT
September 25, 1957.

Upon consideration of appellant's motion to strike or to limit the scope and effect of appellees' brief, and of briefs

in support thereof and in opposition thereto, It is ordered that said motion be, and the same hereby is, denied.

By the Court:
(s) ROGER A. STINCHFIELD
Clerk.

United States Court of Appeals

For the First Circuit

No. 5252.

J. IRIZARRY Y PUENTE,
PLAINTIFF, APPELLANT,
v.
PRESIDENT AND FELLOWS OF HARVARD COLLEGE Et Al.,
DEFENDANTS, APPELLEES.

APPEAL FROM THE UNITED STATES DISTRICT COURT FOR THE DISTRICT OF MASSACHUSETTS.
[149 F. Supp. 33.]

Before MARIS, WOODBURY and HARTIGAN, *Circuit Judges.*

J. Irizarry y Puente, pro se.
Charles B. Rugg, with whom *Oscar M. Shaw, James Vorenberg, Joan Toland Bok* and *Ropes, Gray, Best, Coolidge & Rugg*, were on brief, for appellees.

OPINION OF THE COURT.
October 28, 1957.

MARIS, *Circuit Judge*. The plaintiff has appealed from the summary judgment of the District Court for the District of Massachusetts dismissing his complaint against the defendants, the President and Fellows of Havard College and Erwin N. Griswold, Dean of the Harvard Law School. The complaint alleged in essence that a series of reports on foreign tax systems which the Harvard Law School is preparing makes use of an idea which the plaintiff owned exclusively and which the defendants stole from him. Counts one and four of the complaint allege that the defendants converted to their own use the plaintiff's idea for a tax service disclosed in correspondence between the plaintiff and Griswold in 1950. Counts two and three allege that Griswold deceived the plaintiff into disclosing his plans for a tax service. Damages, an accounting for profits, and injunctive relief were sought.

The plaintiff based his claim upon correspondence passing between himself and Griswold in the spring and summer of 1950. Admittedly there were no other contacts between the parties. The correspondence began with a letter of May 17, 1950 from the plaintiff to Griswold which sought to enlist Griswold's cooperation in looking over the text of a loose-leaf service on Argentine tax law which the plaintiff had prepared and which he planned to follow with similar services on the tax law of other Latin-American nations. The plaintiff stated in the letter that these services were to be "along the lines of the Tax Services published in this country on federal and state taxes by Prentice-Hall or Commerce Clearing House" and that he planned to divide the material into two parts, Part I to be "a text statement on the law of taxation" based "on the statutes, regulations, administrative decisions, court decisions, executive decrees, etc." and Part II to consist "of the annotated statutes, along the lines of U. S. Code Annotated." A copy of the format of Part I was enclosed. In the

letter the plaintiff also stated that a "survey has been conducted among 1500 important business and banking institutions and leading law firms throughout the country in order to determine the measure of interest in such Service, and that the response has been considerable and very favorable."

Griswold replied under date of May 22, 1950 that he found himself interested and requested further information as to just what he would be expected to do and the terms proposed. By letter of May 25, 1950 the plaintiff outlined to Griswold the contemplated steps in the proposed publication, giving further information as to the part Griswold was to take in it and some general suggestions as to compensation. Griswold's job was stated to be to see that the "statement of Argentine law as given in Part I" was in such form that it would "be understood by an American executive or lawyer." Replying on the same day Griswold wrote the plaintiff that he remained interested but still felt the need for more specific and definite information. The plaintiff then wrote Griswold under date of May 29th suggesting a meeting. A copy of the format of Part II of the Argentine Federal Tax Law Service consisting of about 50 pages of printed text was mailed to Griswold. The remainder of the correspondence was devoted solely to the effort to arrange a meeting. The effort was unsuccessful, the two men never met, and the correspondence ended with a letter from Griswold dated August 18, 1950 in which he informed the plaintiff that he did not "care to pursue the matter further".

The plaintiff's Argentine Federal Tax Law Service, to which he referred in his letters to Griswold, was published and copyrighted in 1951. It is a large loose-leaf service with text and annotations of the statutes and regulations and analytical material, priced at $300.00.

The Harvard Law School, in cooperation with the United Nations, is engaged in the preparation and publication of a series of reports on national tax systems of countries throughout the world known as the "World Tax Series". It was

stated at bar that the first two of these reports, those for the United Kingdom and Brazil, were published in the spring of 1957 after the entry of the judgment here on appeal. The project for these reports grew out of discussions starting in October 1950 between representatives of the United Nations and the Harvard Law School. Ever since 1947 the Fiscal Commission of the United Nations has had the responsibility of gathering information on international finance systems to be published in the form of loose-leaf services with an International Tax Law Reporter as a part thereof. In 1951 the Fiscal Commission and the Economic and Social Council of the United Nations passed resolutions approving and authorizing the project of publishing a world tax service with the possible co-operation of universities in the undertaking. Pursuant to these resolutions the cooperation of Harvard University was enlisted but work was not started until 1954 when financial support was secured. A prototype submitted to the District Court, which conforms to one of the subsequently published volumes produced at bar, shows that they are comparatively small permanently bound books summarizing a country's tax system. The price of the United Kingdom and Brazilian reports is stated to be $15.00 and $10.00, respectively.

The defendants moved for summary judgment in their favor. Affidavits and depositions were filed by both parties from which the District Court concluded that there was no genuine issue as to any material fact. The District Court granted the defendants' motion on the ground that there was nothing novel or original in the idea of a foreign tax service which the plaintiff disclosed to Griswold and that the plaintiff accordingly had no proprietary rights in that idea upon which to base his complaint.

The judgment of the District Court must be affirmed because of the lack of novelty and originality of the plaintiff's idea. The reasons for reaching this conclusion are ably stated in the opinion filed in the District Court by Chief Judge

Sweeney, 149 F. Supp. 33, with which we are in full accord. We need only point out here that in contending that it was immaterial whether the idea of a foreign tax service which he disclosed to Griswold was a novel one the plaintiff mistakenly relies upon the rules laid down in copyright cases. It may be conceded that if the defendants were being charged with having copied the text of the plaintiff's copyrighted Argentine Federal Tax Law Service it would be immaterial that the idea of a foreign, or even an Argentine, tax law service was an old and well known one. But the plaintiff does not suggest that the defendants copied the text of his loose-leaf foreign tax law service; he says that they stole from him the idea of publishing such a service. However, unless that idea was a novel and original conception with him he had no property right in it which he could enforce as against the defendants. *Smoley* v. *New Jersey Zinc Co.*, 3 Cir. 1930. 106 F.2d 314.

The defendants urge that the judgment may be supported upon other grounds. While the ground taken by the District Court is sufficient we think it proper to discuss two of these other grounds briefly since we agree that they, too, support the judgment.

The unconditional public disclosure of an idea by the originator makes it the property of all and operates to deprive the originator of any further proprietary rights in it. *Bristol* v. *Equitable Life Assur. Soc. of United States*, 1892, 132 N.Y. 264, 30 N.E. 506; Havighurst, The Right to Compensation for an Idea, 1954, 49 Northwestern U. L. Rev. 295, 301. Here the plaintiff informed Griswold in his first letter that he had already disclosed his idea to "1500 important business and banking institutions and leading law firms throughout the country". Moreover the complaint itself states that "In 1949 the plaintiff caused to be printed a limited number of copies of the formats of Parts I and II in their final form, each format consisting of about fifty pages of printed text, and the said printed formats were used by plaintiff to secure

pre-publication orders for the Argentine volume or service, and based on such formats, a number of orders were so secured." Thus the plaintiff had no basis for a claim against the defendants even if we should assume that the idea had been novel and original with him before such disclosure and that it was actually taken and used by the defendants.

An idea, as distinguished from the copyrighted contents of a book or a patented device or process, is accorded no protection in the law unless it is acquired and used under such circumstances that the law will imply a contractual or fiduciary relationship between the parties. *Chadwick* v. *Covell*, 1850, 151 Mass. 190, 23 N.E. 1068. In the present case it is perfectly clear that no such implied contractual or fiduciary relationship arose. For the plaintiff's initial letter to Griswold, which was wholly unsolicited, disclosed and described the plantiff's entire idea. All that Griswold ever requested from the plaintiff was further information as to the part the plaintiff wished him to take and the financial arrangements which the plaintiff proposed. Such a gratuitous unsolicited disclosure as the plaintiff made to Griswold could not impose upon the defendants a contractual or fiduciary relationship. *Gromback Productions* v. *Waring*, 1944, 293 N.Y. 609. 59 N E. 2d 425; *Laughlin Filter Corp.* v. *Bird Machine Co.*, 1946, 319 Mass. 287, 65 N.E. 2d 545.

The judgment of the District Court will be affirmed.

APPENDIX C

JUDGMENT
October 28, 1957

This cause came on to be heard on appeal from the United States District Court for the District of Massachusetts, and was argued by appellant, pro se, and by counsel for appellees.

Upon consideration thereof, it is now here ordered, adjudged and decreed as follows: The judgment of the District Court is affirmed.

By the Court:

(s) ROGER A. STINCHFIELD
Clerk.

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IN THE

Supreme Court of the United States

October Term, 1957

No. 488 Misc.

J. IRIZARRY Y PUENTE,
PETITIONER,

v.

PRESIDENT AND FELLOWS OF HARVARD COLLEGE AND ERWIN N. GRISWOLD,
RESPONDENTS.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT

BRIEF FOR RESPONDENTS IN OPPOSITION

CHARLES B. RUGG
50 Federal Street
Boston, Massachusetts

OSCAR M. SHAW
JAMES VORENBERG
JOAN TOLAND BOK
ROPES, GRAY, BEST, COOLIDGE & RUGG
Of Counsel

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OPINIONS BELOW

The opinion of the District Court is reported at 149 F. Supp. 33 and appears at pp. 27-30 of the Record Appendix to the Brief for the Appellant in Court of Appeals. The opinion of the Court of Appeals is reported at 248 F. 2d 799 and appears at pp. 30-35 of the Petition.

QUESTIONS PRESENTED

Did the Court of Appeals err in affirming the District Court's summary judgment dismissing this action to recover for alleged misappropriation of the idea for a foreign tax service, when it appeared on uncontroverted facts that

(a) the idea was common knowledge;

(b) petitioner had previously made a full and unconditional disclosure of the idea to a large number of persons; and

(c) there was no fiduciary or contractual relationship between petitioner and respondent Griswold?

STATEMENT

Proceeding Below. The action in this case was commenced by the petitioner J. Irizarry y Puente in January 1956 against President and Fellows of Harvard College and Erwin N. Griswold, Dean of the Harvard Law School. The complaint alleged in essence that a series of reports on foreign tax systems which Harvard Law School is preparing in cooperation with the United Nations makes use of an idea owned exclusively by the petitioner and that the respondents stole the idea from the petitioner. The complaint sought $3,000,000 in damages, an accounting for profits and injunctive relief.

The respondents moved for summary judgment on five grounds (Resp. R. A. pp. 37-38).* The District Court granted this motion on one of these grounds—that the idea of a foreign tax service which petitioner disclosed to Griswold was not novel, and that petitioner therefore had no rights in the idea. The Court of Appeals for the First Circuit unanimously affirmed this

* "Resp. R. A." references are to the Record Appendix to Brief for Appellees in the Court of Appeals, nine copies of which have been filed in this Court by the respondents.

judgment on the same ground and noted that two of the other grounds set forth in respondents' motion for summary judgment also supported the District Court's judgment. These additional grounds were (1) the unconditional and public disclosure by the petitioner of his plan before communicating with Griswold and (2) the lack of any contractual or fiduciary relationship between Griswold and the petitioner.

The Uncontroverted Facts. The facts upon which both courts below reached their decisions were not in dispute. On the basis of the complaint and uncontroverted statements in depositions and affidavits these facts are as follows:

The only communication which has ever taken place between the petitioner and Griswold consists of correspondence between May and August of 1950. The entire correspondence, as identified by petitioner in his deposition, appears in Resp. R. A. pp. 13-30. The first letter was from the petitioner to Griswold. It stated that the petitioner had been working on a loose-leaf tax service for certain countries of Latin America "along the lines of the Tax Services published in this country on federal and state taxes by Prentice-Hall or Commerce Clearing House," and described the plan for his proposed tax service. The letter went on to request Griswold's cooperation in looking over the text which he had prepared on Argentine tax law.

As the Court of Appeals noted in its opinion (Petition, p. 35), all Griswold ever asked petitioner in his letters was for information as to the part petitioner wished him to take and the proposed financial arrangements. He never obtained this information, and after petitioner had failed to keep two appointments Griswold terminated the correspondence.

In his first letter to Griswold petitioner stated that "a substantial survey has been conducted among 1500 important business and banking institutions and leading law firms throughout the country in order to deter-

mine the measure of interest in such Service. . . ." (Resp. R. A. p. 14). On deposition petitioner described this survey which consisted of mailing material describing his plan to 1500 institutions almost a year before he first wrote to Griswold. (Resp. R. A. pp. 65-69 and 31-36). He also referred in deposition to other prior disclosures of his plan.

The petitioner's *Argentine Federal Tax Law Service*, the service referred to in his letters to Griswold, was published and copyrighted in 1951. It is a large, loose-leaf service with text and annotations of the statutes and regulations and analytical material. Its price is $300, and the price for supplemental material after the first year is $150.

The Harvard Law School, in cooperation with the United Nations, is engaged in the preparation and publication of a series of reports on the tax laws and tax administrative procedure of approximately thirty foreign countries. This joint project was suggested to Harvard by a representative of the United Nations as a continuation of work already done by the United Nations in the foreign tax field extending back to 1947.

The reports which the Harvard Law School is publishing are short, hard-bound books summarizing each country's tax system. The first three reports (United Kingdom, Brazil and Mexico) were published during 1957 and are sold at prices of $15, $10 and $12.50, respectively. In the words of the District Court, the Harvard reports are "completely different in size, form, price and content from the plaintiff's *Argentine Federal Tax Law Service*." 149 F. Supp., at 34

Respondents introduced three uncontroverted affidavits describing the many loose-leaf services on United States and foreign taxes (Resp. R. A. pp. 50-58). In addition, an affidavit of a representative of the United Nations described the work of that organization in preparing and distributing foreign tax materials. (Resp. R. A. pp. 40-44)

ARGUMENT

Petitioner's objections to the judgment below are without merit. And since the law concerning common-law protection of ideas is a matter of state law, these objections present no federal question warranting review by this Court.

In the law relating to protection of ideas, it is clear that there are three legal prerequisites to recovery for alleged misappropriation. As the Court of Appeals found, the uncontroverted facts show that none of these has been met here. The first of these prerequisites is that the idea not already have become common knowledge. In asserting that his old idea should be protected, the petitioner fails, as both courts below noted, to distinguish between copyright and idea cases. The petitioner could, of course, recover from one who *copied the text* of his tax service, even though his idea was old. But the present case is not a copyright case. Petitioner does not claim his book was copied; he says his idea for the book was stolen. And it is perfectly clear that one who "owns" an old, well-known idea owns nothing the law will protect. *Masline* v. *New York, N.H. & H. R. Co.*, 95 Conn. 702, 112 Atl. 639 (1921); *Lueddecke* v. *Chevrolet Motor Co.*, 70 F.2d 345 (8th Cir. 1934).

The second prerequisite of protection is that the alleged owner of the idea must have kept it a secret himself. *Gallowhur Chem. Corp.* v. *Schwerdle*, 37 N.J.S. 385, 117 A.2d 416 (1955); *Affiliated Enterprises* v. *Gruber*, 86 F.2d 958, 961 (1st Cir. 1936): ". . . any property right based upon secrecy was lost as early, at least, as the first public exhibition." It would be strange indeed if after a full and unrestricted disclosure of his plan to as broad a list of people interested in foreign taxes as he could put together, petitioner could by an unsolicited letter referring to that very fact bind Griswold to treat the well-known idea as petitioner's own private secret.

The third prerequisite is that there be a fiduciary or contractual relationship between the parties, *Chadwick* v. *Covell*, 151 Mass. 190, 191, 23 N.E. 1068 (1890). As the Court of Appeals pointed out in its opinion (248 F. 2d, at 802), the petitioner's first letter to Griswold, which was wholly unsolicited, disclosed and described petitioner's entire idea; all Griswold ever sought to find out was what the petitioner wished him to do and what the financial arrangements were to be. The Petition seems to argue (pp. 7-9) that the District Court erred in finding that there was no contractual relationship, rather than using the exact words of the complaint and finding no confidential relationship. However, since these are but two ways of stating the rule that the relationship between the parties must show an obligation undertaken to the plaintiff, the District Court was merely expressing the rule in its own words.

On each of these points every relevant fact was before the courts below and none was in dispute. The petitioner's tax service, the prototype of the Harvard reports and uncontroverted affidavits describing similar tax services and materials were before the courts. These — or indeed judicial notice that petitioner's idea was an old one — were all that was needed on the question of novelty. Similarly, the broad prior disclosures and the correspondence between petitioner and Griswold and the surrounding circumstances were introduced in detail by petitioner in his deposition, and thus there was no factual question on the other two grounds upon which the Court of Appeals ruled that the motion for summary judgment should stand.

Thus even if there were some basis to petitioner's claim that there are facts in dispute on the question of misappropriation (which there is not), the judgment below would not be affected. For the three legal grounds on which that judgment is based required dismissal whether or not the alleged misappropriation had taken place.

The petition raised various procedural objections, all of which are groundless. Point II of the Petition is

without merit, since both courts below plainly determined that there was no genuine issue of material fact. Point III fails to recognize that the provisions relating to how issues will be determined on trial are inapplicable where, as in this case, there is no triable issue. And contrary to the claim of Point VIII, the Court of Appeals was correct in denying petitioner's notice to strike or limit respondents' brief and was entitled to exercise the discretion its own rules gave it to deny petitioner's request to file an additional brief after argument.

Summary judgment is most appropriate in this case. For that procedure was designed to avoid the delay and expense of trial where there is no factual issue — and particularly where, as here, the legal claims are frivolous.

CONCLUSION

For the foregoing reasons the Petition for Writ of Certiorari should be denied.

Respectfully submitted,

CHARLES B. RUGG
50 Federal Street
Boston, Massachusetts
Attorney for the Respondents

Of Counsel,
OSCAR M. SHAW
JAMES VORENBERG
JOAN TOLAND BOK
ROPES, GRAY, BEST, COOLIDGE & RUGG

February 7, 1958